

## **REMARKS**

### **Status of Claims**

Claims 1 and 2 are pending. Claims 1 and 2 have been amended, and new claims 3 to 12 have been added. No new matter has been introduced.

### **Overview of the Office Action**

Claims 1 and 2 have been rejected under 35 U.S.C. §103(a) as being obvious over Raines in view of Bressie and further in view of Hess.

The Examiner has objected to the specification and to Claim 1.

### **Amendments addressing formalities**

The word "settling" appearing in the specification and Claim 1 has been objected to by the Examiner. Suitable modifications of a self-explanatory nature have been made to remove this term. Therefore, withdrawal of the objection to the specification and claim 1 is respectfully requested.

### **Summary of subject matter disclosed in the specification and the drawings**

The following descriptive details are based on the specification and drawings. They are provided only for the convenience of the Examiner as part of the discussion presented herein, and are not intended to argue limitations which are unclaimed.

A golf tee includes a burying device 10 and an inserting device 30 coupled to each other by coupling device 40. The inserting device 30 is cone-shaped, and is designed to be inserted into the ground. It is intentionally made of a thin sheet so as to

create very little resistance to the motion of the club as the golfer tees off. Burying device 10 is also cone-shaped and sized to fit within inserting device 30. Burying device 10 is relatively strong so that when it is fitted within inserting device 30, a force exerted on burying device 10 will drive inserting device 30 into the ground.

Coupling device 40 is open on its top and bottom portions. A stack of nested inserting devices 30 extends through an opening in the bottom portion of coupling device 40. The stack is kept from falling through the bottom by blocking jaw 42 of coupling device 40 engaging protrusions 32, 33 of inserting device 30. However, an inserting device 30 can be released if protrusions 32, 33 are brought into alignment with a pair of grooves 44 formed in blocking jaw 42.

Spring 21 is compressed between burying device 10 and the stack of inserting devices 30. Thus, spring 21 acts to release the bottom-most inserting device 30 if its protrusions 32, 33 are in alignment with grooves 44. In order to assist the golfer in attaining such alignment, displaying portions 35 and 45 are provided on inserting device 30 and coupling device 40, respectively.

In operation, as shown in Fig. 6, the golfer aligns displaying portions 35 and 45, and then exerts force on golf ball 50 which is applied via burying device 10 in order to drive inserting device 30 into the ground. When the force on ball 50 is relaxed, spring 21 will cause inserting device 30 to be released from coupling device 40 so that burying device 10, coupling device 40 and the remaining stack of inserting devices 30 can be removed from the bottom-most inserting device 30 which remains in the ground. Ball 50 is then placed on this inserting device 30 so that the golfer can tee off.

## **Descriptive summary of the prior art**

### Raines

A golf tee includes a holder 11 (FIGS. 4-6), which receives a plurality of stacked tees 1, and a plunger unit 17, 15, 14 and 13 for biasing stacked tees inwardly through the holder. Displacement of a tee toward a disengaging position and further disengagement of the tee from the holder is realized by moving springs 19, which are riveted to the holder's outer circumference and have profiled portions extending into the interior of the holder, radially outwardly. See col. 3, lines 32-53

### Bressie

A golf tee is operative to provide the desired height setting of a tee 26, which is manually inserted into a recess 36 of a plunger 34, by displacing the plunger relative to a body 12. After penetration into the ground has been completed, the tee can be disengaged by lifting the body 12. See col. 4, lines 40-60

### Hess

A pencil is configured with a series of detachably connected lead portions having weakened portions between adjacent lead portions. Hess teaches a plurality of leads constituting a pencil and the strips (9b) that "extend longitudinally...throughout the series, the strips being cemented to the cylindrical portions of the sections." See page 2, lines 53-60. Thus, Hess suggests that the strips continuously extend along a plurality of leads and be adhered thereto so as to hold multiple leads together. To remove a lead that becomes dull, the user has to apply a bending force sufficient to separate a portion of the

strip, which is adhered to the dull lead, from the remaining portion of the strip. Otherwise, the dull lead remains attached to the rest of the structure.

### **Patentability of claims over the prior art under 35 USC 103**

#### **Independent claim 1**

Claim 1 has been rejected under 35 USC 103(a) as being unpatentable over Raines in view of Bressi and Hess. The Examiner concedes that Raines does not disclose that the head portion of the burying device is concave. The Examiner relies on Bressi which shows a concave surface 16.

The Examiner also concedes that "Raines... lacks the teaching for inserting device to include a pair of blocking protrusions thereon" but relies on Hess and, more specifically, on thin strip(s) 9b shown in Figs. 5 and 6. Issue is respectfully taken with the Examiner, first, with regard to the applicability of Hess as an appropriate reference to be used against the present application and, second, with respect to whether strips 9b of Hess constitute the claimed blocking protrusions.

It is respectfully submitted that Raines and Hess are drawn from non-analogous arts. There is absolutely no reason why anyone with ordinary skill in the art of designing golf tees would seek to address problems in that art with solutions found in the pencil art. Thus, Hess cannot be combined with Raines because they are drawn from non-analogous arts.

However, even if it were conceded, *arguendo*, that these references can be properly combined, even such a combination would not obviate the present claimed invention. More specifically, Hess does not disclose that strips 9b are arranged to form a

blocking function in association with another component. The sole disclosed function of strips 9b is to connect conical pencil sections 1 to each other. Various embodiments are disclosed for effecting such a connection, including screw threads 9 (Fig. 3), a wrapper 9a (Fig. 4), and of course strips 9b (Figs. 5 and 6). In contrast, protrusions 32, 33 of the present invention engage blocking jaw 42 of coupling device 40. Such a blocking relationship is released only if protrusions 32, 33 are brought into alignment with grooves 44 in blocking jaw 42.

The combination proposed by the Examiner of providing "the stacked tees of Raines with a thin strip" as shown in Hess has no motivation behind it. Such strips would serve no useful function in the Raines arrangement. The Examiner contends that such an arrangement would be useful "in order to facilitate their loading into the tee setting device." However, the loading does not appear to pose a problem for Raines. Moreover, such a strip would interfere with the mechanism of Raines and, in particular, the operation of springs 19 for at least two reasons. Firstly, strips 9b could block inclined surface 24 of springs 19 from protruding through opening 18 in holder 11. Secondly, the presence of strips 9b would displace tees 1 inwardly and away from lips 21 of springs 19 so as to adversely affect their grip on the tees.

Furthermore, if strips 9b were to be added to the stack of tees in Raines, the separation of the bottom-most tee would be blocked. It is imperative that consecutive tees of Raines be separated from one another in order to be removed from the stack. Otherwise, the structure as taught by Raines and shown in FIGS. 4-6 would not be operable because if the inserted lowermost tee of Raines were cemented to the others, as suggested by Hess, it would not remain in the ground upon pulling the holding device

(11). Obviously, such a structure contradicts the teaching of Raines. Thus, Raines teaches away from the suggested combination made by the Examiner.

Consequently, the use of strips 9b in the Raines arrangement is illogical because it would render Raines inoperable. It is respectfully submitted that the Examiner's reasoning in combining Raines with Hess is unsupportable because it is not based on well-reasoned logic. Moreover, the only possible reason for combining these two references is that it relies on hindsight based on the present claimed invention. Of course, this is not permissible. Accordingly, it is respectfully submitted that claim 1 is clearly and patentably distinguishable over the applied references when used singly or in combination. It is respectfully requested that the 35 U.S.C. §103(a) rejection of Claim 1 be withdrawn.

#### Dependent claims

With regard to claim 2, the Examiner contends that "the inserting devices and the coupling device of Raines present an infinite number of portions that are capable of displaying." This statement is unclear to the undersigned. What are the "portions that are capable of displaying" to which the Examiner refers, and where are they located? Moreover, since Raines is conceded by the Examiner to lack a teaching of blocking protrusions, it is not possible for Raines to associate the displaying portions with such blocking protrusions. Accordingly, it is respectfully submitted that claim 2 is allowable not only because it benefits from the allowability of claim 1 but, moreover, it includes features which serve to even more clearly distinguish the invention patentably over the applied references.

The remaining claims are all dependent from claim 1 and, thus, are allowable therewith. In addition, each of these claims includes features which serve to even more clearly distinguish the present invention over the applied references.

### **Conclusion**

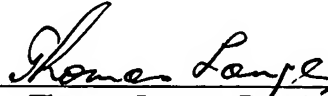
Based on all of the above, it is respectfully submitted that the present application is now in proper condition for allowance. Prompt and favorable action to this effect and early passing of this application to issue are respectfully solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues

Respectfully submitted,

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